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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,602	09/23/2003	Chang-Seob Kim	61610096US	9753

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H.C. PARK & ASSOCIATES, PLC
8500 LEESBURG PIKE
SUITE 7500
VIENNA, VA 22182

EXAMINER

ALEJANDRO, RAYMOND

ART UNIT	PAPER NUMBER
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1745

MAIL DATE	DELIVERY MODE
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07/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/667,602	Applicant(s) KIM, CHANG-SEOB	
	Examiner Raymond Alejandro	Art Unit 1745	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1, 3 and 7-9.
- Claim(s) withdrawn from consideration: 4-6 and 10-22.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Next Page.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

RAYMOND ALEJANDRO
PRIMARY EXAMINER

Raymond Alejandro
 Primary Examiner
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Response to Arguments

1. Applicant's arguments filed 07/05/07 have been fully considered but they are not persuasive.
2. To contend the prima-facie case of obviousness set forth by the Examiner based upon prior legal decisions establishing that the shape of a product is unpatentable (in the absence of objective evidence showing that such a shape or configuration is significant or critical), applicant now has made the comment that *"the arrangement of the current interrupter in the curved portion of the negative electrode lead offers mechanical advantages over the cited references"* and has further pointed out that such a particular shape has the advantage of *"creating a spring effect and to ensure electrical contact between the negative electrode lead 36 and the negative electrode terminal because the stress is greater in the curved portion than in the planar portion of the negative electrode lead 36 due to a P-delta effect that results from a deflection caused by axial loading"* and *"would best ensure "a disconnection at the current interrupter in the event if increased resistance"*. In response, the Examiner asserts that these comments are not sufficient to overcome the prior art of record when taken together with the settled law. The Examiner is of the opinion that the apparent mechanical advantages mentioned above by the Applicant are completely expectable when a change in shape or configuration does occur. The fact that stress is greater at the curved portion instead of the other parts of the negative electrode lead is something that necessarily occurs therein because a force or pressure is being applied to that specific location (i.e. the curved portion). Thus, whatever final result the stressed (curved) portion has on the functionality of the electrode assembly, or ultimately the battery, is something directly associated with the force exerted on that portion. As such, other than miscellaneous changes or

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results, there is nothing particularly significant or critical associated with the change in shape so as to convey a clear idea that the re-shaping of the negative electrode lead produces significant advantages or unexpected results. Thus, the Examiner reasonably believes that applicant's change in shape (the claimed curved portion) does not add to the novelty of the invention in question to the point of affirming critical mechanical advantages other than the ones fully expectable to the concentration of energy (pressure or force) on the curved portion.

MPEP 2144 2144.04 [R-1] Legal Precedent as Source of Supporting Rationale

establishes the following: *As discussed in MPEP § 2144, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. Examples directed to various common practices which the court has held normally require only ordinary skill in the art and hence are considered routine expedients. If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.* As of the issuance of this final rejection, applicant has not asserted or demonstrated a crystal clear criticality for the claimed modification other than commenting that “*the arrangement of the current interrupter in the curved portion of the negative electrode lead offers mechanical advantages over the cited references*”.

However, in a first aspect, as mentioned above, it would be completely expectable to achieve the level of disconnection in the event of increased resistance because when the change in shape takes place at the portion of the negative electrode lead to form the claimed curved portion the application of force or pressure increases the stress level at that specific portion (i.e. the curved portion). Thus, the disconnection advantage is not so significant as it is directly

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related to the applied forced or pressure. It is kinds of an expectable effect-result scenario.

Pressure or force affects the negative electrode lead, and it produces the result of concentrating stress at a particular location.

In a second aspect, objective evidence to support any apparent criticality unexpected result (improvement) has not been forwarded or presented by the applicant. Accordingly, the arguments of counsel cannot take the place of evidence in the record. An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of inherent anticipation/obviousness (See ***MPEP 716.01 and 2145: Consideration of Applicant's Rebuttal Arguments***).

MPEP 716.02(c) [R-2] Weighing Evidence of Expected and Unexpected Result sets forth the following:

- *The evidence relied upon should establish "that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance." Ex parte Gelles, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992) (Mere conclusions in appellants' brief that the claimed polymer had an unexpectedly increased impact strength "are not entitled to the weight of conclusions accompanying the evidence, either in the specification or in a declaration."); Ex parte C, 27 USPQ2d 1492 (Bd. Pat. App. & Inter. 1992) (Applicant alleged unexpected results with regard to the claimed soybean plant, however there was no basis for judging the practical significance of data with regard to maturity date, flowering date, flower color, or height of the plant.). See also In re Nolan, 553 F.2d 1261, 1267, 193 USPQ 641, 645 (CCPA 1977) and In re Eli Lilly, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) as discussed in MPEP §716.02(c).*
- *"Expected beneficial results are evidence of obviousness of a claimed invention, just as unexpected results are evidence of unobviousness thereof." In re Gershon, 372 F.2d 535, 538, 152 USPQ 602, 604 (CCPA 1967) (resultant decrease of dental enamel solubility accomplished by adding an acidic buffering agent to a fluoride containing dentifrice was expected based on the teaching of the prior art); Ex parte Blanc, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989) (Claims at issue were directed to a process of sterilizing a polyolefinic composition which contains an antioxidant with high-energy radiation. Although evidence was presented in appellant's specification*

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showing that particular antioxidants are effective, the Board concluded that these beneficial results would have been expected because one of the references taught a claimed antioxidant is very efficient and provides better results compared with other prior art antioxidants.).



RAYMOND ALEJANDRO
PRIMARY EXAMINER